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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/600,236	07/13/2000	HIRAKU INOUE	450106-02185	9826

20999 7590 07/21/2005
FROMMER LAWRENCE & HAUG
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NEW YORK, NY 10151

EXAMINER

CARDONE, JASON D

ART UNIT	PAPER NUMBER
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2145

DATE MAILED: 07/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/600,236

Applicant(s)

INOUE, HIRAKU

Examiner

Jason D. Cardone

Art Unit

2145

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11, 28-35, 41-60, 77-84 and 90-98 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11, 28-35, 41-60, 77-84, 90-98 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 July 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 12-27, 36-40, 61-76 and 85-89 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 4/21/05.

2. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "the," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

3. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

5. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 recites the limitation "the outside". There is insufficient antecedent basis for this limitation in the claim.

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claim 7 of USPN 6,910,086 contains every element of claims 1, 28, 41, 50, 77 and 90 of the instant application and as such anticipates claims 1, 28, 41, 50, 77 and 90 of the instant application. "A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or **anticipated by**, the earlier claim. In re Longi, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); In re Berg, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus). " ELI LILLY AND COMPANY v BARR LABORATORIES, INC., United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-11, 28-35, 41-60, 77-84 and 90-98 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carson et al. ("Carson"), USPN 5,887,194, in view of Stahl et al. ("Stahl"), USPN 6,665,020.

10. Regarding claim 1, Carson discloses an information processing system, having a plurality of information processing apparatuses connected through a data bus corresponding to a predetermined communication format, for performing a remote control with data and various commands transmitted and received between the information processing apparatuses, comprising; a first information processing apparatus [ie. processor (10), Carson, col. 5, lines 4-18] ; and

a second information processing apparatus having: data recording and reproducing means for reproducing data from a predetermined record medium, recording data thereto, or editing data recorded thereon [ie. audio/video option, Carson, col. 5, lines 30-57];

wherein the first information processing apparatus has: operation information transmitting means for transmitting an operation control command to the second information processing apparatus, the operation control command causing a remote control of a predetermined operation of the data recording and reproducing means of

the second information processing apparatus to be performed [ie. master, Carson, col. 7, lines 15-36]; and

reserve request command transmitting means for generating a reserve request command for requesting the first information processing apparatus for a reservation of a remote control against the second information processing apparatus and transmitting the reserve request command to the second information processing apparatus [ie. lock, Carson, col. 7, lines 37-65]; and

wherein the second information processing apparatus has: receiving means for receiving data transmitted from the outside through the data bus, response processing means for executing a predetermined process corresponding to one of various commands received by the receiving means so as to enable another information processing apparatus to perform a remote control of the second information processing apparatus; local operation controlling means for locally performing an operation control for a predetermined operation against the data recording and reproducing means [audio/video option, Carson, col. 7, lines 42-59 and col. 13, line 63 – col. 14, line 21];

first reserve mode setting means for setting, as a reserve mode to be set corresponding to the reserve request command received by the receiving means, the response processing means so as to permit a remote control by the first information processing apparatus and prohibit a remote control by other information processing apparatuses [ie. lock, Carson, col. 16, lines 4-60]; and

Carson does not disclose a second reserve mode setting means for setting, as a reserve mode to be set corresponding to the reserve request command received by the

receiving means, the local information controlling means so as to enable a predetermined operation of those performed by the local operation controlling means and disable other than the enabled operations. However, Stahl, in the same field of peripheral remote control endeavor, does disclose a second reserve mode setting means for setting, as a reserve mode to be set corresponding to the reserve request command received by the receiving means, the local information controlling means so as to enable a predetermined operation of those performed by the local operation controlling means and disable other than the enabled operations [ie. locking physical controls on device, Stahl, col. 2, lines 19-37 and col. 11, lines 17-47]. It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate a second reserve function, disclosed by Stahl, into the remote controller, disclosed by Carson, in order to control a consumer electronic device from one remote control instead of its front panel.

11. Regarding claim 2, Carson-Stahl further discloses the data bus corresponding to the predetermined communication format is an IEEE-1394 bus [Carson, col. 5, lines 4-18] [Stahl, col. 3, lines 55-67].

12. Regarding claim 3, Carson-Stahl further discloses the second reserve mode setting means of the second information processing apparatus sets the reserve mode to the local operation controlling means so as to enable at least one of a record or

reproduction stop operation, an eject operation for the record medium, and reproduction operations [Carson, col. 7, lines 37-59] [Stahl, col. 7, lines 39-67].

13. Regarding claim 4, Carson-Stahl further discloses the reserve request command transmitting means of the first information processing apparatus transmits the reserve request command when the operation information transmitting means is activated and operated [Carson, col. 16, lines 4-60] [Stahl, col. 11, lines 17-47].

14. Regarding claims 5 and 6, Carson-Stahl further discloses reserve cancellation request command transmitting means for generating a reserve cancellation request command for requesting the second information processing apparatus for a cancellation of the reservation of the remote control and transmitting the reserve cancellation request command thereto, wherein the first reserve mode setting means of the second information processing apparatus causes the response processing means to permit all the other information processing apparatuses connected to the data bus to perform a remote control of the second information processing apparatus corresponding to the reserve cancellation request command received by the receiving means so as to cancel the reserve mode, and wherein the second reserve mode setting means of the second information processing apparatus enables all the operations of the local operation controlling means corresponding to the reserve cancellation request command received by the receiving means so as to cancel the reserve mode, wherein the reserve cancellation request command transmitting means transmits the reserve cancellation

request command when the operation information transmitting means is deactivated [Carson, col. 11, line 26 – col. 12, line 24] [Stahl, col. 10, line 49 – col. 11, line 16].

15. Regarding claim 7, Carson-Stahl further discloses the second information processing apparatus has: bus reset detecting means for detecting an occurrence of a bus reset on the data bus, and wherein when the bus reset detecting means has detected an occurrence of a bus reset, the first reserve mode setting means causes the response processing means to permit all the other information processing apparatuses collected to the data bus to perform a remote control of the second information processing apparatus so as to cancel the reserve mode and the second reserve mode setting means enables all the operations of the local operation controlling means so as to cancel the reserve mode [Carson, col. 11, line 26 – col. 12, line 24] [Stahl, col. 10, line 49 – col. 11, line 16].

16. Regarding claim 8, Carson-Stahl further discloses the second information processing apparatus also has: rejection response transmitting means for transmitting a rejection response to the first information processing apparatus, the rejection response representing the rejection of the reservation of the remote control, when the operation state of the second information processing apparatus prohibits the reservation of the remote control by the first information processing apparatus as a response to the reserve request command received by the receiving means [Carson, col. 11, line 26 – col. 12, line 24] [Stahl, col. 10, line 49 – col. 11, line 16].

17. Regarding claim 9, Carson-Stahl further discloses the reservation of the remote control by the first information processing apparatus is prohibited when the remote control of the second information processing apparatus is reserved by other than the first information processing apparatus [Carson, col. 16, lines 4-60] [Stahl, col. 11, lines 17-47].

18. Regarding claim 10, Carson-Stahl further discloses the reservation of the remote control by the first information processing apparatus is prohibited when an operation control for the editing processing is being performed by the local operation controlling means of the second information processing apparatus [Carson, col. 16, lines 4-60] [Stahl, col. 11, lines 17-47].

19. Regarding claim 11, Carson-Stahl further discloses the first information processing apparatus also has: receiving means for receiving a rejection response transmitted from the second processing apparatus, the rejection response representing a rejection of the reserve request for the remote control by the first information processing apparatus, and presentation means for presenting that the remote control of the second information processing apparatus is prohibited, when the rejection response is received by the receiving means [Carson, col. 11, line 26 – col. 12, line 24] [Stahl, col. 10, line 49 – col. 11, line 16].


Art Unit: 2145

20. Regarding claims 28-35, 41-60, 77-84 and 90-98, claims 28-35, 41-60, 77-84 and 90-98 have similar limitations as claims 1-11. Therefore, the similar limitations are disclosed under Carson-Stahl for the same reasons set forth in the rejection of claims 1-11 [Supra 1-11].

Conclusion

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason D. Cardone whose telephone number is (571) 272-3933. The examiner can normally be reached on Mon.-Th. (6AM-3PM). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Valencia Martin-Wallace can be reached on (571) 272-6159. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jason D Cardone
Primary Examiner
Art Unit 2145

July 20, 2005